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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Toyoshima)	Art Unit: 2683
)	
Serial No.: 09/972,183)	Examiner: Torres
)	
Filed: October 5, 2001)	50P4257.05
)	
For: WIRELESS MODULE SECURITY SYSTEM AND)	May 30, 2004
METHOD)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

APPEAL BRIEF

Commissioner of Patents and Trademarks
 Washington, DC 20231

Dear Sir:

This is an appeal of the final rejections contained in the Office Action dated April 23, 2004. This brief is submitted under 35 U.S.C. §134, and is further to Appellant's Notice of Appeal filed herewith.

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(1) Real Party in Interest

The real party in interest is Sony Corp.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-25 are pending, of which Claims 1-17 and 23-25 have been elected and finally rejected.

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Invention

The invention of Claim 1 is a method for providing security to a wireless module 100, Figure 1, page 4 that includes providing security data to the wireless module from a user computer device 150 including at least one visual display 150b and at least one input device 150a. On the other hand, the invention of Claim 13 is a security system for a wireless module 100 that is configured to receive security data. A peripheral device 150 communicates with the wireless module and is configured to receive security data and transmit peripheral device data. The peripheral device 150 includes a visual display and an input device. Claim 23 recites a wireless module that has electronic serial number and that is configured to be in electronic data

communication with a peripheral device having an input device and a display. The wireless module is configured to store the electronic serial number to the peripheral device.

(6) Issues

(a) Whether the previous amendments to the claims constituted new matter under 35 U.S.C. §132 and, hence whether the disregard of the allegedly new matter in the final rejection is legally proper.

(b) Whether Claims 1, 2, 11-14 and 16 are unpatentable over 35 U.S.C. §102 for being anticipated by Helle.

(c) Whether Claims 23-25 are unpatentable over 35 U.S.C. §102 for being anticipated by Findikli.

(d) Whether Claims 3-7 are unpatentable over 35 U.S.C. §103 for being obvious over Helle in view of Borgelt.

(e) Whether Claims 8-10, 15, and 17 are unpatentable over 35 U.S.C. §103 for being obvious over Helle in view of Borgelt and further in view of Findikli.

(7) Grouping of Claims

The claims are grouped as follows, owing to the different grounds of rejection of each grouping: Claims 1, 2, 11-14 and 16 are a first-group because they have been rejected as being anticipated by Helle, while Claims 23-25, having been rejected as being anticipated by Findikli, are a second group. Claims 3-7 are a third group because they have been rejected as being obvious over Helle in view of Borgelt, while

Claims 8-10, 15, and 17 are a fourth group, having been rejected as being obvious over Helle in view of Borgelt and further in view of Findikli.

(8a) Argument

As an initial matter, it is noted that a new matter objection to the specification has been lodged but that the claims, which recite the allegedly new matter, have not been rejected under 35 U.S.C. §112, first paragraph as is otherwise required by MPEP §2163.06(I). According to MPEP §2163.06(II), a new matter objection to the specification when no new matter has been added to the claims is reviewable by petition only, not by appeal, whereas when the allegedly new matter is added to both the specification and claims, the issue is appealable. In this case, the allegedly new matter has indeed been added to both the specification and claims. The examiner has simply failed to levy the proper rejection to the claims that he is required to have levied after making the objection he has made to the specification. Appellant consequently believes that the failure on the part of the examiner to follow the MPEP and levy a Section 112 does not deprive Appellant the opportunity to have the new matter issue decided on appeal.

It is a pity that this case finds itself at the Board, because the examiner's error regarding the entire point on which this case turns is so manifest and plain that even a cursory supervisory effort would have caught it and stopped it. Appellant amended the claims to structurally distinguish them over what are in fact non-analogous references by specifying that unlike the relied-upon sections of the references, the present peripheral device has an input device and a display. These limitations, however, have been ignored on the ground that they constitute new matter.

A puzzling position, to say the least. First, the facts. The specification as originally filed, page 4, line 25 discloses that the peripheral device 150 can be, among other things, a PC or laptop. This original disclosure is rather relevant because never in the course of human history, to the best of Appellant's knowledge, has a PC or laptop been provided that did not more or less require a display and an input device.

With these facts in mind and undertaking a somewhat novel approach for the present examination by consulting the correct legal standards set forth in the MPEP, §2163 *et seq.* plainly states that the standard for compliance with the written description requirement (and, hence, with whether new matter has been added) is whether, based on the original disclosure, the skilled artisan would conclude that a patent applicant possessed the allegedly new subject matter when the application was filed. In the context of the written description rejection which should have been made in this case but which was not, the burden is on the examiner to explain why the skilled artisan would have not recognized that when Appellant originally disclosed a PC/laptop, Appellant failed to possess the concept that the PC or laptop has an input device and a display. When the proper legal test is stated in the context of the present facts, it is more than understandable why the examiner has not been properly diligent in making his "finding" of new matter. It would have inconveniently required him to abjure from a facile, if legally unsupportable, disposition.

(8b) Argument

The following paragraph applies to all of the claim rejections, and will be stated initially here only once for convenience. The examiner has refused to consider the allegedly new matter of input device and display as now set forth in all the claims. Not only is this procedural error under MPEP §2163.06(I), first paragraph, but, should the Board agree that the allegedly new matter is anything but, it necessarily destroys

the substantive rejections, since each and every one is predicated on refusing to consider the added limitations of input device and display. Accordingly, all rejections have been overcome.

With specific regard to Claims 1, 2, 11-14 and 16, of relevance to the amended claims appears to be the rejections based on Helle, col. 1, lines 9-35, col. 3, lines 5-7, and col. 3, line 64 continuing to col. 4, line 2. Although the Office Action does not articulate what, precisely, in Helle is being used as the claimed "wireless module" and what is being used as the claimed "peripheral device", Applicant believes that the wireless phone of Helle is being used as the "wireless module", since that is the only wireless component shown in Helle and discussed in the sections cited by the Examiner. This means that the only component left that could be used as the claimed "peripheral device" (or host device, etc.) is the SIM card of Helle.

As now amended, the claims require that the peripheral/host device be something more than a card. They require the host to be a computing device that has an input device and a display, unlike a SIM card, which is just a card. The claimed system thus is now something totally different than Helle's system, which is directed solely to the interaction between a SIM card and a wireless phone, not to a wireless module and a user computer device. Because Helle neither teaches nor suggests the claims, they are patentable.

(8c) Argument

Turning to Claims 23-25, Findikli likewise appears to be exclusively directed to mobile phones and their SIM cards. Accordingly, the rejections under this section have been overcome.

(8d) Argument

Claims 3-7 have been rejected under 35 U.S.C. §103 as being obvious over Helle in view of Borgelt. For the reasons set forth above, it does not appear that the relied-upon references teach or suggest the present combination of structure. Moreover, no prior art suggestion exists to support the proposed combination. The proffered suggestion to combine - "for enhanced security" - comes unaccompanied by any prior art citation of support. Certainly, Helle does not suggest that its system requires any "enhanced" security beyond what it provides, and Borgelt does not suggest that systems such as Helle's require "enhanced security". Examiner adherence to the standards of the MPEP is not discretionary, but mandatory.

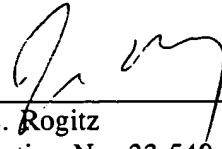
(8e) Argument

Claims 8-10, 15, and 17 have been rejected as being obvious over Helle in view of Borgelt and further in view of Findikli. For the reasons set forth above, it does not appear that the relied-upon references teach or suggest the present combination of structure. Moreover, no prior art suggestion exists to support the proposed combination. The proffered suggestion to combine - "for security and tracking purposes" - comes unaccompanied by any prior art citation of support. Certainly, Helle does not suggest that its system requires any "enhanced" security and tracking measures beyond what it provides, and Findikli does not suggest that systems such as Helle's require better "security and tracking" than they already have.

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APPENDIX A - APPEALED CLAIMS

1. A method for providing security to a wireless module, said method comprising providing security data to the wireless module from a user computer device including at least one visual display and at least one input device.
2. A method for providing security to a wireless module as recited in Claim 1, wherein providing security data comprises providing a security code to the wireless module after the wireless module has been activated.
3. A method for providing security to a wireless module as recited in Claim 2, wherein providing a security code to the wireless module comprises:
 - encrypting said security code;
 - issuing said security code through wireless transmission to the wireless module; and
 - decrypting said security code.
4. A method for providing security to a wireless module as recited in Claim 3, further comprising storing said security code.
5. A method for providing security to a wireless module as recited in Claim 4, wherein storing said security code comprises storing said security code to the wireless module.
6. A method for providing security to a wireless module as recited in Claim 4, wherein storing said security code comprises storing said security code to a peripheral device.
7. A method for providing security to a wireless module as recited in Claim 5, wherein storing said security code further comprises storing said security code to a peripheral device.
8. A method for providing security to a wireless module as recited in Claim 7, further comprising:
 - providing the wireless module with an electronic serial number; and
 - storing said electronic serial number to said peripheral device.
9. A method for providing security to a wireless module as recited in Claim 7, further comprising:
 - providing said peripheral device with peripheral device data; and
 - storing said peripheral device data to the wireless module.
10. A method for providing security to a wireless module as recited in Claim 8, further comprising:
 - providing said peripheral device with peripheral device data; and

storing said peripheral device data to the wireless module.

11. A method for providing security to a wireless module as recited in Claim 2, further comprising notifying a user of a peripheral device of said security code.

12. A method for providing security to a wireless module as recited in Claim 11, further comprising requiring at least one input of said security code into said peripheral device by said user.

13. A security system for a wireless module, said system comprising:
a wireless module configured to receive security data; and
at least one peripheral device in electronic data communication with said wireless module, said peripheral device configured to receive said security data and transmit peripheral device data, said peripheral device including at least one visual display and at least one input device.

14. A security system for a wireless module as recited in Claim 13, wherein said security data comprises a security code, said wireless module configured to store said security code.

15. A security system for a wireless module as recited in Claim 13, wherein said wireless module comprises an electronic serial number, said peripheral device configured to store said electronic serial number.

16. A security system for a wireless module as recited in Claim 14, wherein said wireless module is further configured to store said peripheral device data.

17. A security system for a wireless module as recited in Claim 14, wherein said wireless module comprises an electronic serial number, said peripheral device configured to store said electronic serial number and said security code.

18. A wireless module activation server comprising at least one user activation web site configured to transmit security data useful for establishing a trusted relationship between a wireless module and at least one user computing device having a display and at least one input device.

19. A wireless module activation server as recited in Claim 18, wherein said user activation web site is configured to activate and deactivate the wireless module.

20. A wireless module activation server as recited in Claim 18, wherein said user activation web site is configured to be in electronic data communication with the wireless module configured to store said security data.

21. A wireless module activation server as recited in Claim 18, wherein said user activation web site is configured to be in electronic data communication with the user computing device, the user computing device being configured to store said security data.

22. A wireless module activation server as recited in Claim 18, wherein said user activation web site is in electronic data communication with at least one wireless module account.

23. A wireless module comprising an electronic serial number, said wireless module configured to be in electronic data communication with at least one peripheral device having an input device and a display, said wireless module further configured to store said electronic serial number to at least one peripheral device.

24. A wireless module as recited in Claim 23, further comprising security data.

25. A wireless module as recited in Claim 24, wherein said wireless module is configured to store said security data within said peripheral device.